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| 10/801,425 | 03/16/2004 | Jeremy G. Dunne | LT00043 | 2057 |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/801,425

Applicant(s)

DUNNE ET AL.

Examiner

M. Sager

Art Unit

3714

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 23, 24 and 26-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 23, 24 and 26-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/21/08 and response received 5/21/08 has been entered that deletes claim 25. It is noted that Applicants' submission is not a proper response to prior office action for failing to respond to all issues per 37 CFR 1.111 such as failing to address 103(a) issue in paragraph 3 of office action since remark that 'rejection is moot in view of the amendment to independent claim 23' on page 8 as well as remark on page 11 that newly added claims 'are directed to features of the invention which are not disclosed or suggested in the art of record' are both a general allegation of patentability for not specifically stating what is lacking in references or how the claims avoid the references teachings. Also, the amendment fails to provide clear indication where newly claimed features/steps are taught since remark that support is provided in figures 1-5C and related text of the specification in first paragraph on page 7 includes complete specification thereby failing to specifically state where new features are taught in manner claimed. However, as a service to Applicant, the response has been examined.

Claim Rejections - 35 USC § 112

2. Claims 26-28, 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 26 recites the limitation "said ground condition" line 22 and 'said other factors' line 23. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

3. Claims 23, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zeiner-Gundersen in view of Wilens (5779566) and Hines (5933224). Zeiner-Gundersen discloses a instrument and method teaching entering at least one club type and associated representative user range for said at least one club type to a data store associated with a range finding instrument (abstract, 2:13-55, 3:6-67, 4:55-5:7, 5:58-6:4, 6:43-44, figs 1-5, ref 14), storing in a data store said at least one club type and associated representative user range (abstract, 2:13-55, 3:6-17 and 39-67, 5:58-6:4, figs 1-5, claim 1-2 therein), determining a range to a selected point on a golf course with said range finding instrument such as using a laser rangefinder for short distances (abstract, 2:13-55, 3:6-17 and 39-67, 4:27-31, 4:61-5:7, 5:19-20, 6:43-44, figs 1-5), determining an inclination to said selected point on said golf course with a tilt sensor in the range-finding instrument (abstract, 2:13-55, 3:6-17 and 39-67, 4:19-38, 5:26-35, figs 1-5), determining wind speed and direction with a wind speed sensor and directional sensor in the range-finding instrument (abstract, 2:13-55, 3:6-17 and 39-67, 4:39-47, figs 1-5), entering other factors in the range-finding instrument such as ground condition (abstract, 2:13-55, 3:6-17 and 39-67, 4:55-5:17, figs 1-5), extrapolating a suggested club type appropriate to said determined range from said at least one club type and associated representative user range, inclination, wind speed and direction and other factors (abstract, 2:13-55, 3:6-6:18, esp. 5:23-25), and displaying said suggested club type to a user of said range finding instrument (abstract, 2:13-55, 3:56-5:7, 5:23, 6:5-7:25, figs 1-5). However, Zeiner-Gundersen lacks disclosing the other factors being golf ball type, altitude, and barometric pressure. However, the claimed other factors are each known extrinsic factors that influence player performance as evidenced by

Wilens (abstract, 2:20-5:35, 7:17-27, 11:1-4, 12:28-33, 12:60-13:28, 13:59-16:39, figs. 1-41) that discloses a computerized golf data reporter, advisor unit and method teaching use/displaying of extrinsic factors such as golf ball type, altitude, and barometric pressure for providing golf advice of club type based upon extrinsic factors that effect player performance. Wilens is analogous art at least due to either being in the field of applicant's endeavor of a method and instrument to provide golf advice or, for being reasonably pertinent to the particular problem with which the applicant was concerned of an instrument and method using extrinsic factors as 'other factors' to provide golf club advice. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill in the art is as representative of the skill level of the aforementioned references. Thus, in consideration of US Supreme Court decision in KSR, because Zeiner-Gundersen and Wilens each teach methods of player input of other factors such as ground condition to obtain golf club advice based on extrinsic other factors entered, it would have been obvious to an artisan at a time prior to the invention to apply the process of entering other factors of golf ball type, altitude and barometric pressure to obtain golf club advice as taught by Wilens to improve the golf instrument and method of Zeiner-Gundersen for the predictable result of extrapolating golf club advice based on extrinsic other factors that effect player performance (abstract, 2:20-5:35, 7:17-27, 11:1-4, 12:28-33, 12:60-13:28, 13:59-16:39, figs. 1-41). Essentially, the invention with claimed other factors fails to critically distinguish over the combined teachings of Zeiner-Gundersen with Wilens for a method and instrument that extrapolates a suggested golf club type appropriate to the determined range from entered club type, associated user range, inclination, wind speed and other extrinsic factors that effect player performance. Zeiner-Gundersen with Wilens would further include displaying inclination and

other factors when displaying range as suggested by Wilens (sic) and Zeiner-Gundersen determines cross-lope without having user stand at a right angle to ball by use of a compass (abstract, 2:13-55, 4:19-38, 5:26-7:25, figs 1-5).

Alternatively, where the distance measured is longer than a short distance, Zeiner-Gundersen discloses use of a laser rangefinder for short distances (6:43-44) but does not suggest its use to ascertain distance for longer than a short distance (present invention is not so limiting). Hines (abstract, 2:21-44, 7:3-8:25, 9:50-10:64, 19:14-21:27) discloses a laser rangefinder in golf application that measure from any point on course to another point for range determination. Hines is analogous art at least due to either being in the field of applicant's endeavor of a laser rangefinder used in golf to determine range or, each is reasonably pertinent to the particular problem with which the applicant was concerned of using a laser range-finder to determine range in golf. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill in the art is as representative of the skill level of the aforementioned references. Thus, in consideration of KSR, because Zeiner-Gundersen (with Wilens) and Hines each teach methods of player input of a range to target, it would have been obvious to an artisan to substitute one method for the other to achieve the predictable result of input of range to target using a laser range-finder. The suggestion for use of laser rangefinder over mil-radian process is implicit in the accuracy of the technology, i.e. improved accuracy of distance to target reading for improved club selection. Alternatively, in consideration of US Supreme Court decision in KSR, it would have been obvious to apply the process of a 'laser' range-finder as taught by Hines to improve the method and instrument of Zeiner-Gundersen in view of Wilens for the predictable result of improved accuracy of distance reading that would also improve club suggestion based

on the improved distance reading. Zeiner-Gundersen includes use of laser for determining range that further is evidence that the combination of Zeiner-Gundersen (with Wilens) and Hines would yield predictable results when an artisan considers the combination as a whole at a time prior to the invention.

4. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zeiner-Gundersen in view of Wilens and Hines as applied to claim 23 above, and further in view of Mauritz. Zeiner-Gundersen in view of Wilens and Hines discloses/suggests claimed invention (*supra*) but lacks computing at least said suggested club type and an associated representative user range for said at least one other club type for retention in said data store since Zeiner-Gundersen discloses player entering user performance data for each club type they will use. Similar to player entry of driving distance for clubs as taught by Zeiner-Gundersen, Applicants instant disclosure states (paragraph 18 of pg-pub 2005/0221905) embodiment for a user to enter a plurality of club types and associated ball driving distances in lieu of computing them itself. Thus, the lack of criticality of claimed computing rather than manual entry of club range is noted, or stated differently, the Office acknowledges that entry of driving distance for each club used taught by Zeiner-Gundersen is an alternative equivalent process to claimed 'computing at least said suggested club type and an associated representative user range for said at least one other club type'. Also, the claimed 'for retention in said data store' is deemed obvious over Zeiner-Gundersen due to its teaching for storing performance data for use to indicate a suggested club (*supra*).

However, Mauritz discloses recommending a particular golf club type for a range based on personal data (abstract, 1:47-2:14, and figs. 1-4). Applicants' admission regarding these

ranges as reflected by 'computing at least said suggested club type and an associated representative user range for said at least one other club type' was old and well known to an artisan and that these ranges can be found by a look-up table, a simple algorithm or similar technique as remarked @ 8:15-9:2 in their amendment received Nov 29, 2007 is noted. The computing of a range for clubs from table based on personal data of golfer taught by Mauritz is equivalent to remarked 'examples' cited by Counsel/Applicant as a known process for computing estimate of distance for a club given general information about a user and a representative distance of at least one club stated in cited amendment. The lack of criticality of manner of computing the admitted known computation for one other correlated data set is acknowledged. Zeiner-Gundersen enters user height and weight as a power factor or other factor used in extrapolating a suggested club based on range to target (abstract, 2:13-55, 3:6-67, 4:55-5:7, 5:58-6:4, 6:43-44, figs 1-5, ref 14); while, Mauritz also relies in part on personal data of golfer such as height and weight (sic). The level of ordinary skill in the art is as representative of the skill level of the aforementioned references. Where a golfer/user may not know the personal performance range of a particular golf club type such as might occur prior to initial use of a particular golf club type, it would have been obvious to an artisan at a time prior to the invention to add 'computing at least said suggested club type and an associated representative user range for said at least one other club type' as based on personal performance characteristic such as height and weight of golfer as taught by Mauritz as an admitted equivalent process to improve the golf device of Zeiner-Gundersen for the predictable result of using personal user data to suggest a club type including consideration of a new/different golf club type where player has no prior performance history with at least one other club type. The 'for retention in data store' is

deemed obvious due to Zeiner-Gundersen teaching storing performance data for use in suggesting club type.

Further, alternatively, 'computing at least said suggested club type and an associated representative user range for said at least one other club type' does not solve any Applicant stated problem or purpose. While, Zeiner-Gundersen discloses an instrument and method having claimed structure including a process to suggest a club based on input of user's golf data but lacks claimed computing. Because Zeiner-Gundersen, Mauritz and admitted prior art process each teach methods of entering or input of user play/performance data used to suggest a golf club, it would have been obvious to an artisan at a time prior to the invention to apply the process of computing at least said suggested club type and an associated representative user range for said at least one other club type as an admitted known process based on personal performance characteristic such as height and weight of user as taught by Mauritz to improve the instrument and method of Zeiner-Gundersen so as to achieve the predictable result of entering or user input of play data used to suggest a club type including for a new/different club type that a player who has no prior performance history with at least one club type. The lack of criticality of claimed computing one other correlated data set indicative of another club type is noted by admission in aforementioned amendment received 11/29/07. The 'retention in data store' is deemed obvious due to Zeiner-Gundersen teaching storing performance data for use in suggesting club type.

5. Claims 1-7, 10, 12, 26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zeiner-Gundersen (6059672) in view of Mauritz (5283732) and Hines (5933224). Reply to Applicants' asserted patentability is provided below and incorporated herein. Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be

performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are (A) “adapted to” or “adapted for” clauses; (B) “wherein” clauses; and (C) “whereby” clauses. The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “whereby” clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.” *Id.* However, the court noted (quoting *Minton v. Nat’l Ass’n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a “whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.”” *Id.* In this case, the ‘wherein’ clauses do not specify a condition that is material to patentability or they simply express an intended result of process; however, the claimed clauses were treated. Also, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In *re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board’s finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). The teachings of *Zeiner-Gundersen*

discussed above with respect to claim 23 is incorporated herein. Zeiner-Gundersen discloses a range finding instrument comprising a user input for providing data to said instrument indicative of at least one golf club type and at least one user range for said at least one golf club type and for entering a ground condition at selected point for possible alteration of suggested club type based on range and ground condition (abstract, 2:13-55, 3:6-4:17, 4:55-5:7, 5:58-6:4, 6:43-44, figs 1-5, ref 14), a data store associated with the instrument and user input for maintaining the at least one golf club type and at least one representative user range for the at least one golf club type (abstract, 2:13-55, 3:6-67, 4:55-5:7, 5:58-6:4, 6:43-44, figs 1-5, ref 14), a processor coupled to data store (abstract, 2:13-55, 3:6-67, 4:55-5:7, 5:58-6:4, 6:43-44, figs 1-5, ref 20), a laser rangefinder for short distances or optic rangefinder (5:18-25, 6:43-44, ref 24), an in-sight display coupled to the processor and said laser rangefinder for indicating a suggested club type based on correlated data set and determined range to selected point for indicating a suggested golf club type for short distances or an optic rangefinder, to indicate a determined range, wherein said display is an in-sight display, to indicate angular inclination of selected point, to indicate wind speed and direction, to indicate ground condition, entering user identification associated with correlated data sets (abstract, 2:13-55, 3:6-67, 4:17-5:25, 5:42-7:25, ref 22), a tilt sensor (abstract, 2:13-55, 3:6-67, 4:19-38, 5:26-41, figs. 1-5, ref 30, 32), a wind speed and direction sensor (3:52) but lacks the processor performing claimed function of 'computing at least one other correlated data set indicative of another golf club type and associated representative user range based upon a relationship in said first correlated data set' (claim 1 and 26) since Zeiner-Gundersen discloses player entering user performance data for each club type they will use.

Similar to player entry of driving distance for clubs as taught by Zeiner-Gundersen, Applicants instant disclosure states (paragraph 18 of pg-pub 2005/0221905) embodiment for a user to enter a plurality of club types and associated ball driving distances in lieu of computing them itself. Thus, the lack of criticality of claimed computing rather than manual entry of club ranges is noted, or stated differently, the Office acknowledges that entry of driving distances for each club used taught by Zeiner-Gundersen is an alternative equivalent process to claimed 'computing at least one other correlated data set indicative of another golf club type and associated representative user range based upon a relationship in said first correlated data set'.

In the alternative, however, Mauritz discloses recommending a particular golf club type for a range based on personal data (abstract, 1:47-2:14, and figs. 1-4). Applicants' admission regarding 'computing at least one other correlated data set indicative of another golf club type and associated representative user range based upon a relationship in first data set' and 'computing at least said suggested club type and an associated representative user range for said at least one other club type' was old and well known to an artisan and that these ranges can be found by a look-up table, a simple algorithm or similar technique as remarked in amendment received Nov 29, 2007 @ 8:15-9:2 is noted. The computing of a range for clubs from table based on personal data of golfer taught by Mauritz is equivalent to remarked example cited by Counsel/Applicant as a known process for computing estimate of distance for a club given general information about a user and a representative distance of at least one club stated in cited amendment. The lack of criticality of manner of computing the admitted known computation for one other correlated data set is acknowledged. Zeiner-Gundersen enters user height and weight as a power factor or other factor used in extrapolating a suggested club based on range to

target (abstract, 2:13-55, 3:6-67, 4:55-5:7, 5:58-6:4, 6:43-44, figs 1-5, ref 14); while, Mauritz also relies in part on personal data of golfer such as height and weight (sic). The level of ordinary skill in the art is as representative of the skill level of the aforementioned references. Where a golfer/user may not know the personal performance range of a particular golf club type such as might occur prior to initial use of a particular golf club type, it would have been obvious to an artisan at a time prior to the invention to add 'computing at least one other correlated data set indicative of another golf club type and associated representative user range based upon a relationship in said first correlated data set' and 'computing at least said suggested club type and an associated representative user range for said at least one other club type' as based on personal performance characteristic such as height and weight of golfer as taught by Mauritz as an admitted equivalent process to improve the golf device of Zeiner-Gundersen for the predictable result of using personal user data to suggest a club type including consideration of a new/different golf club type where player has no prior performance history with at least one other club type. The 'retention in data store' is deemed obvious due to Zeiner-Gundersen teaching storing performance data for use in suggesting club type.

Alternatively, 'computing at least one other correlated data set indicative of another golf club type and associated representative user range based upon a relationship in said first correlated data set' does not solve any Applicant stated problem or purpose. While, Zeiner-Gundersen discloses an instrument and method having claimed structure including a process to suggest a club based on input of user's golf data but lacks claimed computing. Because Zeiner-Gundersen, Mauritz and admitted prior art process each teach methods of entering or input of user play/performance data used to suggest a golf club, it would have been obvious to an artisan

at a time prior to the invention to apply the process of computing at least one other correlated data set indicative of another golf club type and associated representative user range based upon a relationship in said first correlated data set and computing at least said suggested club type and an associated representative user range for said at least one other club type as an admitted known process based on personal performance characteristic such as height and weight of user as taught by Mauritz to improve the instrument and method of Zeiner-Gundersen so as to achieve the predictable result of entering or user input of play data used to suggest a club type including for a new/different club type that a player who has no prior performance history with at least one club type. The lack of criticality of claimed computing one other correlated data set indicative of another club type is noted in light of admission of process being old and well known. The 'retention in data store' is deemed obvious due to Zeiner-Gundersen teaching storing performance data for use in suggesting club type.

Further, *arguendo*, where the distance measured is longer than a short distance, Zeiner-Gundersen discloses use of a laser rangefinder for short distances (6:43-44) but does not suggest its use to ascertain distance for longer than a short distance (present invention is not so limiting). Hines (abstract, 2:21-44, 7:3-8:25, 9:50-10:64, 19:14-21:27) discloses a laser rangefinder in golf application that measure from any point on course to another point for range determination. Hines is analogous art at least due to either being in the field of applicant's endeavor of a laser rangefinder used in golf to determine range or, each is reasonably pertinent to the particular problem with which the applicant was concerned of using a laser rangefinder to determine range in golf. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill in the art is as representative of the skill level of the aforementioned references.

Thus, in consideration of US Supreme Court decision in KSR, because Zeiner-Gundersen (with Mauritz) and Hines each teach an instrument of a range to target, it would have been obvious to an artisan to substitute one method for the other to achieve the predictable result of determining range to target using a laser range-finder. The improvement for use of laser rangefinder over mil-radian process is implicit in the accuracy of the technology, i.e. improved accuracy of distance to target reading for improved club selection. Alternatively, in consideration of KSR, it would have been obvious to apply the process of a 'laser' rangefinder as taught by Hines to improve the instrument of Zeiner-Gundersen in view of Mauritz for the predictable result of improved accuracy of distance reading that would also improve club suggestion based on the improved distance reading. Zeiner-Gundersen includes use of laser for determining range that further is evidence that the combination would yield predictable results when an artisan considers the combination as a whole at a time prior to the invention.

6. Claims 8-9, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zeiner-Gundersen in view of Mauritz and Hines as applied to claim 1 above, and further in view of Jenkins (5294110) or Jones (4136394). Response to Applicants' asserted patentability is provided below and incorporated herein. Zeiner-Gundersen in view of Mauritz and either Harris or discloses claimed instrument (*supra*) except entering a wind speed and direction where such entry is manual) at least since Zeiner-Gundersen includes a wind speed and direction sensor. Jenkins and Jones each disclose an instrument teaching user input for entering a wind speed and direction for possible alteration of suggested club type based upon determined range. The level of ordinary skill in the art is as representative of the skill level of the aforementioned references. In consideration of US Supreme Court decision in KSR, because Zeiner-Gundersen (in view of

Mauritz and Hines) and Jenkins or Jones each teach methods of entering wind data including its speed and direction for suggesting a club type based on range to target, it would have been obvious to an artisan at a time prior to the invention to substitute one method for the other to achieve the predictable result of indicating a suggested golf club type based on correlated data sets, determined range and manually entered extrinsic factors of wind speed and direction. Also, it is known to an artisan to be obvious to perform manually the steps of a prior automated process that accomplishes the same result is not sufficient to distinguish over prior art; which is the case here. Further, regarding scope of display to indicate wind speed and direction is analogous to discussion above regarding display indicating wind speed and direction or inclination or a ground condition that is incorporated herein. Finally, the lack of criticality as to manner of entering wind data is noted with respect to manual or automated (i.e. sensor) input.

7. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zeiner-Gundersen in view of Mauritz and Hines as applied to claim 26 above, and further in view of Wilens. Zeiner-Gundersen in view of Mauritz and Hines discloses/suggests claimed instrument (supra) and includes other factors being ground conditions (supra), but lacks the other factors being altitude of course and golf ball type and displays... other factors. However, the claimed other factors of altitude and golf ball type are each known extrinsic factors that influence player performance as evidenced by Wilens (abstract, 2:20-5:35, 7:17-27, 11:1-4, 12:28-33, 12:60-13:28, 13:59-16:39, figs. 1-41) in that Wilens discloses a computerized golf data reporter, advisor unit and method teaching use/displaying of extrinsic factors such as golf ball type, altitude, and barometric pressure for providing golf advice of club type based upon extrinsic factors that effect player performance. Wilens is analogous art at least due to either being in the

field of applicant's endeavor of a method and instrument to provide golf advice or, for being reasonably pertinent to the particular problem with which the applicant was concerned of an instrument and method using extrinsic factors as 'other factors' to provide golf club advice. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill in the art is as representative of the skill level of the aforementioned references. Thus, in consideration of US Supreme Court decision in KSR, because Zeiner-Gundersen (with Mauritz and Hines) and Wilens each teach methods of player input of other factors such as ground condition to obtain golf club advice based on extrinsic other factors entered, it would have been obvious to an artisan at a time prior to the invention to apply the process of entering other factors of golf ball type, altitude and barometric pressure to obtain golf club advice as taught by Wilens to improve the golf instrument and method of Zeiner-Gundersen in view of Mauritz and Hines for the predictable result of extrapolating golf club advice based on extrinsic other factors that effect player performance (abstract, 2:20-5:35, 7:17-27, 11:1-4, 12:28-33, 12:60-13:28, 13:59-16:39, figs. 1-41). Essentially, the invention with claimed other factors fails to critically distinguish over the combined teachings of Zeiner-Gundersen in view of Mauritz and Hines and further Wilens for a method and instrument that extrapolates a suggested golf club type appropriate to the determined range from entered club type, associated user range, inclination, wind speed and other extrinsic factors that effect player performance. Zeiner-Gundersen in view of Mauritz and Hines and further Wilens would further include displaying inclination and other factors when displaying range as suggested by Wilens (sic).

Response to Arguments

8. Applicant's arguments filed 5/21/08 and 8/21/08 have been fully considered but they are not persuasive. First, as noted above, Applicants' submission is not a proper response in accordance with 37 CFR 1.111 to prior action for failing to properly reply to all issues in prior action and failing to provide where newly claimed features are taught.

Regarding characterization of KSR remark on page 7 of paper rec'd 8/21/08, the Office is confused by Counsel/Applicants' remark since no such characterization was stated by Office in any correspondence with Counsel/Applicants and the Office does not adhere to such characterization of KSR as remarked by Counsel/Applicants. However, the Office maintains that findings of fact as shown above in holdings that the combination of prior art when taken as a whole at a time prior to the invention, the combination suggests the claimed instrument and method or stated differently, the claimed instrument and method fails to critically distinguish over the references when taken as a whole at a time prior to the invention.

Regarding Counsel/Applicants' remark on page 9 of submission rec'd 8/21/08 that art of record lacks a data store associated with the instrument and user input for maintaining the at least one golf club type and at least one representative user range for the at least one golf club type, the Office disagrees and notes Counsel/Applicants' misrepresentation of prior art fails to be persuasive since Zeiner-Gundersen clearly includes a data store (abstract, 2:13-55, 3:6-67, 4:55-5:7, 5:58-6:4, 6:43-44, figs 1-5, ref 14) in manner claimed as noted in prior action incorporated herein that is same structure performing same function for same purpose. The misrepresentation by Counsel/Applicants regarding the teachings of the prior art is not well taken. Also, the prior action did not state inherency but rather stated a data store was implicit as in implicitly contained

in the reference as cited therein (abstract, 2:13-55, 3:6-67, 4:55-5:7, 5:58-6:4, 6:43-44, figs 1-5, ref 14), while Counsel/Applicants focus solely on the data input reference and omit review of citations within (i.e. implicit rather than inherent) for consideration of Zeiner-Gundersen as a whole. Thus, the Counsel/Applicants narrow/limited review of prior art is not persuasive for failing to consider art as a whole. Further, the reference to microprocessor was merely further evidence of there being memory and was not relied upon for teachings stated therein. Thus, Counsel/Applicant is also misquoting the basis of facts. However, due to possible misunderstanding by Counsel/Applicants of basis, so as to be clear as to facts where features are clearly taught as a service, Zeiner-Gundersen includes a data store as facts stated in holding above incorporated herein in manner claimed at least from following (note highlighted text includes entered and stored in memory so as to be recalled from memory by microprocessor for stated comparison to suggest club type).

The **microprocessor** portion of the subject device is unitized to **process the manually inputted data** and the collected sensor information. A suitable microprocessor is the AT 90S8515 AVR RISC produced by the Atmel Corporation. The microprocessor will be a low powered micro-controller with a relatively high processing power and information storage capacity. The microprocessor will typically include at least one analog comparator. The software for the microprocessor will typically be a specially tailored software program capable of handling the sensor data from the laser scanner, humidity reader, compass (relative heading of the housing at any time), the inclinometer (the relative positioning of the housing with respect to a plane horizontal to the ground), the wind speed and direction sensor and the tested and calculated deacceleration of the ball while rolling on the green, and the preprogrammed equation that will be used to calculate the undulation of the green and the calculated rolling path. The **calculated value for golf club selection (the club selection will be manually input)** will be displayed in the form of a curve and or by other simple means.

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The program will typically utilize the online available sensor data, such as compass, inclinometer, wind directional and speed sensor, the calculated roll resistance, and the calculations preformed to determine the undulation, configuration and distance to the flag. **This calculated data will be combined and compared with values that were originally entered**, such as the height of the golfer, typical length of drives for that person, selected grass configurations for that course.

The data entry mode is used by the golfer to select and input the following data: selection of the type of measurements to be displayed (English or metric); the height and or weight of the golfer (to calculate the expected force which will be applied to the ball and determine the distance to the ball will be carried toward the hole); **input of how far the individual golfer can hit the ball while driving with the woods or irons** (this input is determined by trial and may never need to be reset unless wanted); **selection of how far the individual golfer can hit the ball while pitching with high loft and with low loft** (this input is determined by trial and error also); selection of type of grass; manual input of the length of the fairway grass if extremely long or short, special environmental conditions.

Thus, contrary to Counsel/Applicants' assertion, it is clear to an artisan that previously cited portions show a golfer manually inputs (ref 14) the ranges that the golfer drives each particular club (abstract, 2:13-55, 3:6-67, 4:55-5:7, 5:58-6:4, 6:43-44, figs 1-5) and that correlated data set as input is stored and recalled for use by the microprocessor (ref 20) on the course to suggest a club type based on range to target on the course that teaches a data store associated with the instrument and user input for maintaining the at least one golf club type and at least one representative user range for the at least one golf club type that is same structure performing same function for same purpose.

In response to applicant's argument on page 10 of reply received 8/21/08 that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be

recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Contrary to Counsel/Applicants' assertion, the standard of patentability remains as what the prior art suggests to an artisan when taken as a whole at a time prior to the invention. In this case, as stated above in holding incorporated herein, the combination of Zeiner-Gundersen with Hines (as specifically respectively combined above) when taken as a whole at a time prior to the invention, the combination suggests to an artisan an instrument and method using a laser rangefinder to determine an improved accuracy of range to target from position on golf course for indicating an improved suggested golf club type. The suggestion for use of a laser rangefinder over mil-radian process is as stated in prior action and herein, that the improved accuracy inherent with use of laser rangefinder over mil-radian process would suggest use of the laser over optic process for improved club suggestion thereby. The inherent accuracy of laser rangefinder over optic process was admitted by Counsel/Applicants on page 6 of their remarks rec'd 5/21/08. Regarding argument regarding failure to consider complexity of a laser rangefinder instrument and no reasonable expectation of success on page 10-11, the Office respectfully disagrees. The Office has never conceded that Zeiner-Gundersen did not teach use of a laser rangefinder to determine distance since as stated in prior action, the holding on page 5 indicates 'as noted by Applicants in their remarks' that it is Counsel/Applicants that assert Zeiner-Gundersen does not use a laser rangefinder. Contrary to Counsel/Applicants' contention, Zeiner-Gundersen teaches use of a

laser rangefinder for short distances while Hines suggests use of laser rangefinder for any distance (supra). Thus, with due consideration that the standard of patentability remains as what the prior art suggests to an artisan when taken as a whole at a time prior to the invention, the complexity of laser rangefinder and expectation for success is considered/taught thereby when the combination of prior art is taken as a whole at a time prior to invention (sic).

In addition, the facets on page 6 of response rec'd 5/21/08 whether mil-radian optic process is useable on a golf course based on circumstances of the course arrangement (i.e. visibility of flag or target) stated by Counsel/Applicants is not an element of claims and thus do not bear upon determination whether invention is novel/non-obvious. Specifically, those facets pertain to manner of use that similarly to optic mil radian process that is line of sight (LOS), an obscured target poses difficulty for a laser rangefinder that is also LOS.

Applicants' admission @ 8:15-9:2 of Amendment, received 11/29/07, regarding computing at least one other correlated data set indicative of another golf club type and associated representative user range based on a relationship in first data correlated data set and computing at least said suggested club type and an associated representative user range for said at least one other club type being well known to an artisan is noted and that the computation is a known calculation such as by table, simple algorithm or similar technique. The lack of criticality of process to compute/enter remaining club data is noted due to instant disclosure relies upon the admitted known process where manner of computing is not critical since cited remarks lists general known process to compute club range.

The new claims 26 and 30 encompass various sensor inputs and displaying of the data from claims 4-7, thus are considered issues previously treated over art of record. The user input

for entering other factors claimed by claim 26 as best understood therein applies to 'said ground condition' that is taught by Zeiner-Gundersen (*supra*).

9. Applicant's arguments with respect to claims 23-24, and 26-31 have been considered but are moot in view of the new ground(s) of rejection. The claimed sensors in claim 23 were also previously in claims 4 and 6 and have been shown to be taught by art of record. The newly claimed 'other factors' specified to be golf ball type, altitude and barometric pressure (claims 23, 27) pertains to known extrinsic factors used in golf as basis for altering suggested club as shown by Wilens (previously of record), where 'other factors' such as ground condition was also taught by Zeiner-Gundersen (*sic*). The newly claimed compass and determining a cross-lope without having said user stand at a right angle to the ball and/or pin (claims 30-31) is taught by Zeiner-Gundersen (previously of record). Since all newly claimed features and added claims claim features either previously treated by art of record or are taught by combination of art of record, a final on first action is deemed proper. MPEP 706.07(b). Although new claims and new features were claimed, the prior art of record and specifically art that was applied to prior pending claims (no new art was used) teaches/suggests such features. Finally, for clarity, Zeiner-Gundersen teaches display to indicate ground condition (abstract, 2:13-55, 3:6-17 and 3:39-4:18, 4:55-5:17, 6:35-7:25, figs 1-5) of claim 11 that was inadvertently associated with claim 1 rather than claim 8 from which it depends. This is not a change in interpretation of art or of claim, but is only to correct typographical dependency association and is over same art of record.

Conclusion

10. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art

of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Sager/
Primary Examiner, Art Unit 3714